

REMARKS:

Claims 15-19 have been cancelled and applicant has substituted claims 20-25 to more properly reflect the specifications of the present patent application.

In order to overcome the claims rejection under 35 USC 103 (a) as being unpatentable over Pappolla in view of Shapiro, the applicant would like to request reconsideration of this rejection for the following reasons:

1. By substituting the new claims of a chitosan salt of indole-3-propionic acid (claims 20-25) applicant overcomes the objections of the last office action. The novel physical features of claim 20 (new) produce new and unexpected results and hence are unobvious and patentable over Pappolla and Shapiro. The new chemical entity resulting from claim of 20 (new) has properties distinctively different from each of its constituent components. In addition, the new chemical entity, a chitosan salt of indole-3-propionic acid, is completely different from any composition disclosed by Pappolla or Shapiro.
2. The novel physical features of claim 20 (new) produce new and unexpected results and hence are unobvious and patentable over these references. Applicant points out that the patent application teaches the use of a new chemical entity that results from adding poorly water-soluble indole-3-propionic acid to water, stirring, then adding water-insoluble chitosan. The chemical reaction resulting from this produces a new compound never before seen. The compound is a chitosan salt of indole-3-propionic acid that has properties distinctively different from each of its constituent components. Applicant points out that the present

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patent application teaches the use, as well as the synthetic methodology, of a new chemical entity, that is, a chitosan salt of indole-3-propionic acid, that renders water-insoluble chitosan and poorly water-soluble indole-3-propionic acid completely water-soluble as well as very stable.

3. The simple mixture or placement of indole-3-propionic acid with or in proximity to chitosan does not result in the formation of the new compound. The mixture of these two molecules must take place in water with stirring as disclosed in the present patent application. Thus even if combined physically such as a mixture of the powder of indole-3-propionic acid with chitosan powder, no new chemical compound results.
4. The present application teaches that the new compound resulting from the synthetic methodology disclosed in the application (that is, indole-3-propionic acid stirred in water, chitosan added, water stirred, filtered and then dried) has never been seen before. In the applicant's view, there is no possible physical way that a combination of the references of Pappolla in view of Shapiro could result in the new water-soluble compound that is the subject of the current patent application.

The references and Differences of the Present Invention

The applicant will discuss the references and the general novelty of the present invention and its unobviousness over the references. Pappolla discloses the use of known compound indole-3-propionic acid as an antioxidant. Pappolla does not disclose the use of chitosan to make a salt of indole-3-propionic acid to make it water-soluble and stable.

Shapiro discloses among others, the use of chitosan, for example, to be used to trap carbonyl products generated from sugars in the food product during food processing. Shapiro does not disclose the compound that is the subject of the applicant's patent application.

Shapiro and Pappolla do not contain any justification to support their combination, much less in the manner proposed.

With regard to the proposed combination of Shapiro and Pappolla, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior art 103 rejection, the references themselves (or some other prior art) must suggest that they be combined. (E.g. As was stated in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983) “Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2D, 1434 (C.A.F.C. 1988) “where prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art must suggest the desirability and thus the obviousness of making the combination. “

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Date: 9.10.05

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Conclusion

For all of the above reasons, applicant submits that the claims are now in proper form, and that the claims all define patentably over the prior art. Therefore, applicant submits that this application is now in condition for allowance, which action the applicant respectfully solicits.

Conditional Request for Constructive Assistance.

Applicant has amended the claims of this application so that they are proper, definite, and define novel chemical structures that are also unobvious. If, for any reason, this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. 706.03 (d) and 707.07 (j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,

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Even if Pappolla and Shapiro were to be combined in the manner proposed, the proposed combination would not show any or all of the novel physical features of claim 20 (new).

If the combination Pappolla and Shapiro were justified, claim 20 (new) would still have novel (and unobvious) physical features over the proposed combination. In other words, the applicant's invention, as defined in claim 20 (new) comprises much more than a simple combination of indole-3-propionic acid and chitosan.

Specifically, claim 20 (new) clearly distinguishes applicant's invention from the proposed combination by virtue of the fact that the chemistry of the individual chemicals involved in the invention (that is, indole-3-propionic acid and chitosan) are changed by the synthetic methodology disclosed. Two poorly water-soluble compounds are rendered completely water soluble via the applicant's present invention. Neither Pappolla nor Shapiro knew of this compound resulting from the applicant's synthetic methodology. Thus Pappolla and Shapiro lack the essential element that is fundamental to the applicant's present invention.

Thus the applicant submits that the novel physical feature of claim 20 (new) is unobvious and hence patentable under 103 since it produces new and unexpected results over Pappolla and Shapiro or any combination thereof.